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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,347	05/09/2005	Hansjorg Ander	RO4016US (#90568)	4202
7590 D. Peter Hochberg Co. 1940 East 6th St. 6th Floor Cleveland, OH 44114		06/04/2007	EXAMINER BERNSHTEYN, MICHAEL	
			ART UNIT 1713	PAPER NUMBER
			MAIL DATE 06/04/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/534,347

Applicant(s)

ANDER ET AL.

Examiner

Michael Bernshteyn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01/22/2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action follows a response filed on January 22, 2007. Claim 1 has been amended; no claims have been cancelled or added.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 22, 2007 has been entered.
3. Claims 1-13, 15 and 16 are pending.

Claim Rejections - 35 USC § 102

4. The test of this section of Title 35 U.S.C. not included in this action can be found in a prior Office Action.

Claim Rejections - 35 USC § 103

5. The test of this section of Title 35 U.S.C. not included in this action can be found in a prior Office Action.
6. Claims 1-9, 12, 13 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Inagi et al. (EP 0 735 122 A2), for the rationale recited in paragraph 4 of Office Action dated on April 25, 2006.

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7. Claims 10-11 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable as obvious over Inagi et al. in view of Weaver et al. (U. S. patent 6,713,641), for the rationale recited in paragraph 5 of Office Action dated on April 25, 2006.

8. Claim 15 is rejected under 35 U.S.C. 102(b) as being anticipated by Inagi et al. (EP 0 735 122 A2), for the rationale recited in paragraph 8 of Office Action dated on October 19, 2006.

Response to Arguments

9. Applicants traverse the rejection of claims 1-9, 12, 13, 15 and 16 under 35 U.S.C. 102(b) as being anticipated by Inagi et al. (EP 0 735 122 A2). Applicant's arguments have been fully considered but they are not persuasive.

10. Applicants submit that claim 1 has been amended to delete the recitation of "can be produced" in favor of the recitation "is produced." It is respectfully submitted that claim 1, as amended, clarifies that the polymer composition of the present invention consists only of the three groups of polymers as set forth in claim 1 and excludes the usage of other components in the polymer composition (pages 6-7, the bridging paragraph).

Applicants contend that Inagi et al. teach an adhesive base material comprising a polymer obtained by polymerization of (1) a glucosyloxyalkyl (meth) acrylate, (2) a hydroxyalkyl (meth)acrylate, (3) an alkyl(meth) acrylate and (4) a polyfunctional monomer. At page 2, line 54, Inagi et al. states that the polymer with the desired properties of the invention thereof is obtained by polymerization of the aforementioned

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"specific four monomers". In other words, the polymer according to Inagi, et al. is derived from at least four different monomers, one of those being a glucosyloxy (meth)acrylate, wherein the glucosyloxy group includes various monosaccharides and oligosaccharides with up to 10 saccharide units.

Contrary to the teaching of Inagi, the polymer of the present invention is obtained by polymerizing (1) a polar (meth)acrylate with a Zerewitinoff hydrogen, (2) an apolar (meth)acrylate, and (3) a bi-, tri- or higher functional (meth)acrylate, or of a (poly)functional compound (page 7).

Hence, the polymer of the present invention is derived only from three different monomers set forth above and in claim 1, none of which is a glucosylox (meth)acrylate (page 8, 1st paragraph).

11. It is noted that claim 1 contains the following "A polymer composition which is **produced** by polymerization of ..." The recitation of claim 1 "is produced" does not exclude the usage of another components in the polymer composition.

Inagi's composition contains exactly the same three different monomers like the claimed composition with addition exactly the same amount of the same initiator and exactly the same amount of the same chemically inert medium (see the previous Office Action).

It is further noted that according MPEP 2111.03 [R-3], only the transitional phrase "consisting of" excludes any element, step, or ingredient not specified in the claim. In re Gray, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948) ("consisting of" defined as "closing the claim to the inclusion of

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materials other than those recited except for impurities ordinarily associated therewith.”).

Therefore, as per claim 1, it is the examiner position that the phrase “is produced” is synonymous with “comprising”, “including,” “containing,” or “characterized by,” is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., *Mars Inc. v. H.J. Heinz Co.*, 377 F.3d 1369, 1376, 71 USPQ2d 1837, 1843 (Fed. Cir. 2004) (“like the term comprising,’ the terms containing’ and mixture’ are open-ended.”)

Therefore, all the limitations of instant claim 1 are expressly met by Inagi.

12. Applicants further submit that this difference between the two compositions, which at first might only appear to consist of omitting one additional monomer, is in actuality a substantial difference when one compares the properties of the respective resulting polymers. The polymer of Inagi, et al. has excellent skin adhesion properties and swelling properties when impregnated with a solvent, i.e., a swelling rate of at least 300% (Inagi, et al., page 2, lines 53, 54; page 5, line 12). The present polymer also has excellent adhesion, but in connection with polar and semi-polar substances, such as glass, metal and polycarbonate (paragraphs [00002] and [00003] of the present specification). Furthermore, the present invention is inert to chemical influences and moisture (paragraph [00008]) and does not swell, since swelling would result in cohesive failure or detachment of the 'adhesive from the surface (paragraph [00007]) (page 8, 2nd paragraph).

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13. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the present invention is inert to chemical influences and moisture, and does not swell, etc.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

14. Applicants traverse the rejection of claims 10-11 and 15 under 35 U.S.C. 103(a) as being unpatentable as obvious over Inagi et al. in view of Weaver et al. (U. S. patent 6,713,641). Applicant's arguments have been fully considered but they are not persuasive.

15. Applicants contend that as the Inagi, et al. reference should clearly not be considered as prior art, one skilled in the art would have had no reason to combine the teachings of the disclosure therein with those of Weaver, et al. Furthermore, the combination of both disclosures would still lead to compositions containing glucosyloxy alkyl (meth)acrylate with properties that would likely resemble those of the composition disclosed by Inagi, et al. On the other hand, it would be questionable whether such proposed compositions would share characteristics such as those of the present invention.

In conclusion, it is submitted that one skilled in the art would not have considered combining ingredients of an adhesive, used in medical preparations, having good swelling properties and favorable adhesion to skin and a non-adhesive polymer coating for use in X-ray films to obtain a non-swelling, chemically inert adhesive with good

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adhesion to glass and the like, in particular when the exchange of a polymer component is required in addition to the removal of one specific monomer component in order to achieve the desired properties of the present invention. Therefore, it would not be clear to one skilled in the art to combine the teachings of the cited references in order to arrive at the present invention (page 12).

16. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

17. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

18. In response to applicant's argument that Weaver's references is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the

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claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

In this case, Weaver's reference discloses a **coating composition** wherein the polymerizable vinyl compounds comprise a solution of a polymeric, polymerizable vinyl compound selected from acrylated and methacrylated polyesters, acrylated and methacrylated polyethers, acrylated and methacrylated epoxy polymers, acrylated or methacrylated urethanes, and mixtures thereof, in a diluent selected from monomeric acrylate and methacrylate esters (claim 17, col. 25, lines 24-31). The acrylated or methacrylated polymers and oligomers typically are combined with monomers, which contain one or more acrylate or methacrylate groups, e.g., monomeric acrylate and methacrylate esters, and serve as reactive diluents. The unsaturated polyesters, which are prepared by standard polycondensation techniques known in the art, are most often combined with either styrene or other monomers, which contain one or more acrylate or methacrylate groups and serve as reactive diluents (col. 13, lines 9-17).

The coating compositions are suitable as adhesives and coatings for such substrates as metals such as aluminum and steel, plastics, glass, wood, paper, and leather (US'641, col. 15, lines 62-65).

Therefore both references are analogous art because they are from the same field of endeavor concerning coating and pressure sensitive adhesive polymer compositions.

19. In the light of the discussion above, the rejection of record has not been withdrawn. The rejection remains in force.

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Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bernshteyn whose telephone number is 571-272-2411. The examiner can normally be reached on M-F 8-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Bernshteyn
Examiner
Art Unit 1713

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